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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,545	10/15/2003	Christopher H. Porter	355492-4200	7701
38706 75	590 01/31/2006		EXAMINER	
FOLEY & LARDNER LLP			JONES, DAMERON LEVEST	
1530 PAGE MILL ROAD PALO ALTO, CA 94304		ART UNIT	PAPER NUMBER	
TALOALIO,	CA 74304		1618	
		DATE MAILED: 01/31/2006		

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)			
Office Action Summary		10/687,545	PORTER ET AL.			
		Examiner	Art Unit			
		D. L. Jones	1618			
	The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
WHIC - Exter after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. Operiod for reply is specified above, the maximum statutory period we are to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim rill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).			
Status						
1)⊠	Responsive to communication(s) filed on 11/8/05; 6/7/04; 6/10/04; 1/0/20/05; & 3/.					
′=	This action is FINAL . 2b)⊠ This action is non-final.					
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposit	ion of Claims					
5)□ 6)⊠ 7)□	Claim(s) 1-18 is/are pending in the application. 4a) Of the above claim(s) 8,12 and 13 is/are with Claim(s) is/are allowed. Claim(s) 1-7,9-11 and 14-18 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or	thdrawn from consideration.				
Applicati	ion Papers					
10)⊠	The specification is objected to by the Examiner The drawing(s) filed on 15 October 2003 is/are: Applicant may not request that any objection to the Replacement drawing sheet(s) including the correction The oath or declaration is objected to by the Example 1.	a)⊠ accepted or b)⊡ objected drawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).			
Priority (ınder 35 U.S.C. § 119					
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: Certified copies of the priority documents have been received. Certified copies of the priority documents have been received in Application No Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
	e of References Cited (PTO-892)	4) 🔲 Interview Summary				
3) 🔯 Infor	te of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) or No(s)/Mail Date 11/8/05 & 6/7/04.	Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	ate atent Application (PTO-152)			

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ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the following: (1) the amendment filed

3/12/04 wherein the specification was amended; (2) the amendment filed 6/10/04

wherein claim 3 was amended; (3) the amendment filed 10/20/05 wherein claims 19-24

were canceled.

Note: Claims 1-18 are pending.

APPLICANT'S INVENTION

2. The instant invention is directed to compositions and uses thereof wherein the

composition comprises a prepolymeric material and a rheological modifier.

RESPONSE TO APPLICANT'S ELECTION

3. Applicant's election with traverse of Group II (claims 1-18) filed 10/12005 is

acknowledged. The traversal is on the ground that searching the full scope of the

instant invention would not be a burden on the Examiner. This is found non-persuasive

because the inventions are separate and distinct. A search of one group would neither

anticipate nor render obvious another group. Hence, searching the full scope of the

instant invention would be burdensome to the Examiner. Thus, the restriction

requirement are still deemed proper and is therefore made FINAL.

Notes: It is duly noted that Applicant elected the species wherein the

prepolymeric material is 2-hydroxyethyl methacrylate; the rheological modifier is fumed

silica; the contrast agent is tantalum; the thickening agent is carboxymethyl cellulose;

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the plasticizer is glycerol esters; the radioactive agent is 125iodine; the surfactant is Tween; and the medicament is a thrombotic agent. The search was not further expanded because prior art was found which could be used to reject the instant invention. Claims 1-7, 9-11, and 14-18 read on the elected species.

WITHDRAWN CLAIMS

4. Claims 8, 12, and 13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

DOUBLE PATENTING REJECTIONS

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-7, 9-11, and 14-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 4, 6, 7, 10-13, 15, 16, and 21-25 of copending Application No. 10/686,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions comprising a polymeric material and a theological modifier. The claims differ in that those of 10/686,929 requires the presence of a non-reactive biocompatible substance, a rheological modifier, a biocompatible liquid, and a contrast agent while the instant invention only requires the present of a biocompatible liquid and a contrast agent. Thus, it would be obvious to one of ordinary skill in the art that both the instant invention and that of

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10/686,929 disclose overlapping subject matter. Furthermore, its is noted that both the instant invention allows for additional components to be present in the composition.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

103 REJECTIONS

- 7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 8. Claims 1-7, 9-11, and 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson et al (US 2004/0224864).

Patterson et al disclose sterilize embolic compositions that may be administered to a subject via a catheter and may comprise a contrast agent, prepolymer, and optionally thickeners and/or theological modifiers for diagnostic and therapeutic purposes (see entire document, especially, abstract; page 2, paragraph [0030]; and pages 2-3, bridging paragraph). Peterson et al also disclose that the one may use thickeners and/or rheological modifiers since both the thickener and modifier act to enhance the static viscosity such that the flow properties of the composition under static conditions is significantly reduced (page 2, paragraph [0030]). In another embodiment,

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the composition comprises (1) a biocompatible polymer; (2) a biocompatible solvent; (3) optionally, a biocompatible water insoluble contrast agent; and (4) a fumed silica or other hydroxyl containing theological modifier (page 3, paragraph [0048]). The method of embolizing a vascular site in a mammal comprises delivering the composition via a catheter (page 3, paragraph [0051]). Possible modifiers include carboxymethylcellulose (page 7, paragraph [0117]). Possible biocompatible contrast agents include water insoluble contrast agents such as tantalum, tantalum oxide, gold, tungsten, platinum, and barium sulfate. Likewise, water soluble contrast agents such as lipidol and metrizamide may be utilized (page 8, paragraphs [0129] and [0130]). A possible biocompatible prepolymer is hydroxyethyl methacrylate (page 9, paragraph [0140]). In addition, surfactants (i.e., Tween) and biocompatible plasticizers which Patterson et al disclose that the particular plasticizer employed is not critical (page 10, paragraphs [0147] and [0148]). On page 11, paragraph [0173], Patterson et al disclose that other combinations besides silica, ethylene vinyl alcohol copolymer, DMSO, and tantalum may be utilized. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a composition comprising a rheological modified and a prepolymeric material because both Applicant and Patterson et al disclose compositions comprising such components.

COMMENTS/NOTES

9. Applicant is not entitled to the date of the provisional application, 60/418,251 filed 10/15/02, because one could not locate each component as set forth in the instant

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invention. If Applicant is in disagreement with the Examiner, it is respectfully requested that Applicant point to page(s) and line number(s) wherein support may be found for the instant invention.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Primary Examiner
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